

REMARKS**Summary of the Office Action**

Claims 1-3 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,522,889 to Aarnio (hereinafter “Aarnio”) and further in view of U.S. Patent 6,420,977 to Corbitt et al. (hereinafter “Corbitt”).

Claims 4-20 are allowed.

Summary of the Response to the Office Action

Applicants have amended claim 21 to improve the form of the claim. Accordingly, claims 1-21 remain pending for consideration. The Examiner is thanked for the indication that claims 4-20 are allowed.

The Rejections under 35 U.S.C. §§ 103(a)

Claims 1-3 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Aarnio and further in view of Corbitt. This rejection is respectfully traversed as follows.

As explained in the Amendment filed on May 14, 2004, the instant application involves a portable information terminal equipped with a display. It also involves a system for providing the portable information terminal with image information obtained by imaging an inside condition of a shop, for example. This allows a user to determine the conditions within the shop, such as how crowded the shop is currently, before deciding whether or not to go shopping there.

The specification discusses, with regard to Fig. 9, for example, that the user's portable telephone 10 or personal digital assistant 10' sends position data to an interior image information providing site S1. The interior image information providing site S1 sends to the portable

telephone 10 or personal digital assistant 10' image information provided by facility sites based on the received position data. See, for example, page 31, lines 12-20.

As a result, the user's portable device, 10 or 10', sends a position signal to an interior image information providing site S1. If the user is standing within a store, or the vicinity of a store, of which data is stored within the interior image information providing site S1, the corresponding interior data for that particular store will be sent to the user's portable device via the interior image information providing site S1. See, for example, page 42, lines 3-14.

The Final Office Action, at pages 2-3, alleges that Aarnio discloses each element of independent claims 1 and 21, for example, except for the "image signal reproducing part, which reproduces, said image signal received by means of said image signal receiving part and makes said display part display said reproduced image." However, the Final Office Action then applies Corbitt as allegedly meeting these limitations. The Final Office Action alleges, in making this combination rejection, that "it would have been obvious ... to modify the device of Aarnio by specifically adding features makes the display part display said reproduced image in order to increase system's overall capacity as taught by Corbitt et al." Applicants respectfully traverse this combination rejection for at least the following reasons.

Aarnio discloses an apparatus for providing precise location information through a communication network. As illustrated in Fig.1, a mobile station (MS) 12 transmits an image of an object (such as a geographic region proximate to the MS) through the mobile communications system to the computer network. A converter server such as an OCR server 20 converts the digital image to a bit format, for example, binary text. The binary text is compared with the location database data in a location server (LS) 22. Once a location or "match" is identified, the location is transmitted back to the MS. See, col. 4, lines 6-27 of Aarnio.

Corbitt, on the other hand, discloses a system which facilitates the visual monitoring of a dangerous location, the system including a stationary camera device (110) and at least one mobile display device (120) corresponding to at least one vehicle. The mobile display device (120) receives the video signals from the camera device (110) and presents the video signals as a video image of the dangerous location to a driver of the vehicle.

Applicants respectfully submit that if the disclosure of Corbitt is added to the device of Aarnio as suggested by the Examiner in the combination rejection under 35 U.S.C. § 103(a), the result would be such that a video image from a stationary camera device is displayed on a display of the mobile station of Aarnio.

However, Applicants respectfully submit that the recited combinations of the portable information terminal and the interior image information providing site defined in independent claims 1 and 21, respectively, of the present application could not be obtained by the suggested addition of the feature of Corbitt to the apparatus of Aarnio.

Applicants respectfully submit that such a combination would not produce any improvement in operation of the apparatus of Aarnio. For example, if a video image from a desired stationary camera device (outside the mobile station 12 of Aarnio) is to be displayed on a display of the mobile station 12, steps performed by the elements defined in claims 1 and 21 of the present application would still have to be followed in order to select one camera device from a plurality of candidates.

More particularly, claims 1 and 21 of the present application each recite that position information representing an own position of the portable information terminal is transmitted from the portable information terminal. This feature is necessary to perform the desired display operation discussed above.

On the other hand, the apparatus of Aarnio is designed to operate such that the image taken by the camera device is transmitted to the computer network, and a precise location station is transmitted back to the mobile station. With regard to the system of Corbitt, the display device receives the video signal when the corresponding vehicle is in proximity to the camera device. This means that the transmission of position information is unnecessary in a system such as Corbitt.

For at least the foregoing reasons, Applicants respectfully submit that the Office Action's suggested combination of the feature of Corbitt would result in a mere aggregation of a location (position determination) feature and a video image display feature into the arrangement of Aarnio in a manner that is clearly different from the features of the portable information terminal and the interior image information providing site combinations respectively recited in claims 1 and 21 of the instant application. For example, one skilled in the art would not be motivated to provide Corbitt's image display feature into Aarnio's mobile station 12, as proposed by the Office Action, because Aarnio teaches away from such a combination. In particular, as discussed above, Aarnio teaches sending an image from the camera 13 through the mobile communications system 14 to the computer network 18. It does not suggest any need for such an image to be returned for display at the mobile station 12. Such an advancement would only be gained through hindsight after viewing the details of the instant application's claimed combinations.

As a result, Applicants respectfully submit that there is no motivation taught or suggested by the cited references to modify the teachings of Aarnio with the teachings of Corbitt to obtain the claimed combinations recited in claims 1 and 21 of the instant application. Applicants submit that only through hindsight would one be motivated to modify Aarnio to meet the

limitations of the claims. MPEP § 2141, under the heading "Basic Considerations Which Apply to Obviousness Rejections," points out that "the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention." [See also Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 229 USPQ 182 (Fed. Cir. 1986).] The Federal Circuit has clearly held that "the motivation to combine references cannot come from the invention itself." Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21 F.3d 1068, 30 USPQ 2d 1377 (Fed. Cir. 1993).

Absent any teaching or suggestion *in the prior art* to adapt the teachings of Aarnio to meet the claimed invention, the rejection under 35 U.S.C. § 103(a) is improper. If the Office Action's assertion of motivation being taught by the prior art is reasserted, Applicants respectfully request that the specific location of such a teaching (i.e., column and line numbers) in the prior art be pointed out in the next Office Communication. Accordingly, Applicants respectfully submit that the rejections under 35 U.S.C. § 103(a) of independent claims 1 and 21 should be withdrawn. Moreover, Applicants respectfully submit that dependent claims 2-3 are allowable for at least the same reasons as independent claim 1, on which they depend. Withdrawal of the rejections of dependent claims 2-3 is thus also respectfully requested.

The Examiner is thanked for the indication that claims 4-20 are allowed. However, for at least the foregoing reasons, Applicants respectfully submit that claims 1-3 and 21 are also in condition for allowance.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the entry of the Amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after

consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite the prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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